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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,056	08/20/2001	Christophe Person	LXGN-00103	6732

7590

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EXAMINER

LY, CHEYNE D

ART UNIT

PAPER NUMBER

2168

DATE MAILED: 12/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/933,056	<b>Applicant(s)</b> PERSON, CHRISTOPHE	
	<b>Examiner</b> Cheyne D. Ly	<b>Art Unit</b> 2168	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 October 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 26 and 28-56 is/are pending in the application.
- 4a) Of the above claim(s) 31-41, 47-49, 52, 53, 55 and 56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26, 28-30, 42-46, 50, 51 and 54 is/are rejected.
- 7) ☒ Claim(s) 26, 31-41, 47-49, 52, 53, 55 and 56 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

1. The art unit designated for this application has changed. Applicants(s) are hereby informed that future correspondence should be directed to Art Unit 2168.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 17, 2005 has been entered.
3. Applicants' arguments have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.
4. Claims 31-41, 47-49, 52, 53, 55, and 56 are withdrawn.
5. Claims 26, 28-30, 42-46, 50, 51, and 54 are examined on the merits.

### **OBJECTIONS**

6. Claim 26 is objected to because of the incorrect spelling of the term "interative," line 12. Appropriate correction is required.

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7. Claim 31-41, 47-49, 52, 53, 55, and 56 are objected to because the withdrawn claims do not have the claim text. See 37 CFR §1.121. Appropriate correction is required.
8. The title of the invention is not descriptive because the claimed invention is directed to the “generating a database...,” while the instant title is directed to the creating of... a sequence file.” A new title is required that is clearly indicative of the invention to which the claims are directed.

### **Sequence Compliance**

9. This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR § 1.821(a)(1) and (a)(2). See, for example, Figure 3. However, this application fails to comply with the requirements of 37 CFR § 1.821 through 1.825 because Figure 3, contain nucleic acid sequences with sequence lengths that are equal to or greater than 10 nucleic acid molecules and these sequences do not have SEQ ID Nos cited along with each sequence in the specification or Figure. Applicants are also reminded that SEQ ID Nos are not required in Figures per se, however, the corresponding SEQ ID Nos then are required in the Brief Description of the Drawings section in the specification. Applicants are also reminded that a CD-ROM sequence listing submission may replace the paper and computer readable form sequence listing copies. Applicant(s) are required to submit a new computer readable form sequence listing, a paper copy for the specification, statements under 37 CFR § 1.821(f) and (g), if there is a need to list additional sequences in the listing. Applicant(s) are given the same response time regarding this failure to comply as that set forth to respond to this office action. Failure to respond to this

requirement may result in abandonment of the instant application or a notice of a failure to fully respond to this Office action.

**CLAIM REJECTIONS - 35 U.S.C. § 112, SECOND PARAGRAPH**

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 26, 28-30, 42-46, 50, 51, and 54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
12. Claim 26, line 5, recites “random short sequences” which causes said claim to be vague and indefinite in regard to the limitation of “sequences that are greater than or equal to about 100 nucleotides in length” recited in the preamble. When the claim is read as a whole, the metes and bounds of said limitation is not clear. For example, are the “short sequences” less than 100 nucleotides, greater than 100 nucleotides, or equal to 100 nucleotides?
13. Claim 26, lines 8 and 10, recites the limitation of “identified unique sequences,” there is insufficient antecedent basis for this limitation in the claim. Claim 26 does not identified the “identified unique sequences” for the comparison starting in line 6.
14. Claim 26, line 8, recites “remembering the same” wherein the metes and bounds of the limitation is not clear because it is not clear what is being remembered as being the same.
15. Claims 26, 28-30, 42-46, 50, 51, and 54 have been rejected for being dependent from claim 26.

**CLAIM REJECTIONS - 35 USC § 112 FIRST PARAGRAPH**

16. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

17. Claims 26, 28-30, 42-46, 50, 51, and 54 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. NEW MATTER.
18. Specific to claim 26, line 5, the limitation of “random short sequence...” has not been found in the pointed to support (page 4, lines 16-21). It is noted that the pointed to support discloses “sequence fragments” without specifying any sequence lengths.
19. Specific to claim 26, line 6-7, the limitation of “to create a contig masked query sequence capable of masking novel repetitive elements” has not been found in the pointed to support (page 15, lines 1-8). It is noted that the pointed to support discloses “A contig is a group of overlapping DNA segments...,” which is different from the new limitation.
20. Specific to claim 26, line 10, the limitation of “remembering same” has not been found in the instant specification. Further, the limitation has not been previously mentioned as asserted by Applicant by the symbol “Id.”

21. Specific to claim 26, lines 11-13, the limitation of “in order to reassemble the data therein via an interactive learning process into an assembly with those in the known repeat/masking database” has not been found in the pointed support (page 29, lines 3-14). It is noted that the pointed to support discloses the building of a unique file which is different from the new limitation. Further, page 11 discloses “recursive computational procedure for solving a problem,” which is also different from the new limitation.

### CONCLUSION

22. It is noted that the prior art rejection has been withdrawn as necessitated by the claim amendments.
23. Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables

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applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

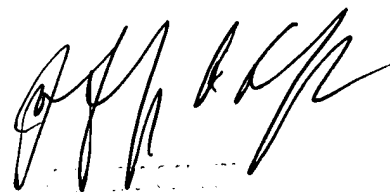
24. For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199. The USPTO's official fax number is (703) 872-9306.

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Dune Ly, whose telephone number is (571) 272-0716.

The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

26. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin, can be reached on (571) 272-4146.

C. Dune Ly / *CDL*  
Patent Examiner  
12/1/05

A handwritten signature in black ink, likely belonging to Jeffrey Gaffin, the supervisor mentioned in the text. The signature is stylized and appears to be 'J. Gaffin'.